



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,854	09/27/2000	Ikuyo Ikeda	196466US 2	6529

22850 7590 02/24/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

TRAN, QUOC A

ART UNIT PAPER NUMBER

2176

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,854

Applicant(s)

IKEDA, IKUYO

Examiner

Quoc A. Tran

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 15-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to Amendment A, filed 12/09/2004.
2. Claims 15-24 are currently pending in this application. Claims 15, 18, 21 and 24 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-16, 18-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al. US005566278A - filed 08/24/1993 (hereinafter '278), in view of Lee. US Patent No. 6,208,427 B1 issued 03/27/2001 filed 11/18/1997 (hereinafter '427).

In regard to independent claim 24, "activating a printer driver to perform", as described by '278 at col. 2, lines 20-35 (i.e.... FIG. 1 represents a prior art personal computer system. In order to provide printing functions, the application program 102 interacts (as shown schematically by arrow 108) with printer driver software 110. Printer

driver software 110 is generally associated with an application program and reformats and converts the printable information as necessary...).

'278 does not explicitly teach, *"displaying an original document on a screen as a preview of printing; receiving, at least one of a text, an image, and a graphic to be inserted into an image of the displayed original document from a user; receiving a position specified by the user on the displayed image on the screen so as to form a space for inserting the at least one of the text, image, and graphic; inserting the at least one of the text, image, and graphic into the formed space; and displaying a combined image on the screen"*, however as taught by '427 at col. 2, lines 25-55 (i.e. printing method has also been developed for a PDA which has a display capable of displaying characters and graphic data, a fax modem capable of transmitting and receiving fax data, and a memory capable of storing data...user interface through the display that allows a user to select a fax note stored in the memory, insert/remove a fax header, and set upper, lower, right, and left margins...selecting one of an insertion and removal menu...setting upper, lower, right, and left margins...converting the note and the margin instructions into bit map image data...).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified '427 into '278 to provide a way, wherein displaying an original document on a screen as a preview of printing; receiving, at least one of a text, an image, and a graphic to be inserted into an image of the displayed original document from a user; receiving a position specified by the user on the displayed image on the screen so as to form a space for inserting the at least one of the

text, image, and graphic; inserting the at least one of the text, image, and graphic into the formed space; and displaying a combined image on the screen. One of the ordinary skills in the art would have been motivated to perform such a modification to provide the printing system includes objects that provide queries for device identification, optimized imaging, printer status, data transfer, and control methods such as a grafport and printer drivers are provided for each printer type within the operating system. Thus, an application not only need not worry about the particular printer/computer combination with which it is to operate, but also need not have a built in document formatting capability, as taught by '278 at Abstract (i.e... An object-oriented printing system includes objects that provide query, data transfer, and control methods...).

In regard to independent claims 15 and 18, are directed to a recording medium for performing the method of claim 24, and is similarly rejected under the same rationale.

In regard to dependent claim 16, "*A controlling device for a printing image*", as described by '278 at col. 2, lines 20-35 (i.e.... FIG. 1 represents a prior art personal computer system. In order to provide printing functions, the application program 102 interacts (as shown schematically by arrow 108) with printer driver software 110. Printer driver software 110 is generally associated with an application program and reformats and converts the printable information as necessary...).

'278 does not explicitly teach, "*the inserting device reduces the image to be printed and moves the reduced image in up-and-down and right-and-left directions on the screen so as to form a space for inserting the at least one of the text, image, and*

Art Unit: 2176

graphic", however as taught by '427 at col. 2, lines 25-30 (i.e. The printing... providing a user interface through the display that allows a user to select a fax note stored in the memory, insert/remove a fax header, and set upper, lower, right, and left margins... selecting one of an insertion... setting upper, lower, right, and left margins ...).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified '427 into '278 to provide a way, wherein inserting device reduces the image to be printed and moves the reduced image in up-and-down and right-and-left directions on the screen so as to form a space for inserting the at least one of the text, image, and graphic. One of the ordinary skills in the art would have been motivated to perform such a modification to provide the printing system includes objects that provide queries for device identification, optimized imaging, printer status, data transfer, and control methods such as a grafport and printer drivers are provided for each printer type within the operating system. Thus, an application not only need not worry about the particular printer/computer combination with which it is to operate, but also need not have a built in document formatting capability, as taught by '278 at Abstract (i.e... An object-oriented printing system includes objects that provide query, data transfer, and control methods...).

In regard to dependent claim 19, *"a computer in which the printer driver program according to claim 18 is installed"*, as taught by '278 at col. 2, lines 20-35 (i.e.... FIG. 1 represents a prior art personal computer system. In order to provide printing functions, the application program 102 interacts (as shown schematically by arrow 108) with printer driver software 110. Printer driver software 110 is generally

associated with an application program and reformats and converts the printable information as necessary...).

In regard to dependent claim 20, "and a printer", as taught by '278 at col. 8, lines 15-25 (i.e.... printer 422...).

In regard to independent claim 21, is directed to an apparatus for performing the method of claims 24, and is similarly rejected under the same rationale.

In regard to dependent claim 22, incorporate substantially similar subject matter as cited in claim 16 above, and is similarly rejected along the same rationale.

Claims 17, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable by Patel et al. US005566278A - filed 08/24/1993 (hereinafter '278), in view of Lee US Patent No. 6,208,427 B1 issued 03/27/2001 filed 11/18/1997 (hereinafter '427), further in view of Hansen et al US patent No. 6,462,756 B1 issued 10/08/2002 filed 05/17/2000 (hereinafter '756).

In regard to dependent claim 17, is directed to an apparatus for performing the method of claim 24, and in further view of the following, and are similarly rejected under the same rationale;

'278 and '427 do not explicitly teach "*the combined image is edited by a drag and drop operation on the preview of printing*", however as taught by '756 at col. 9, lines 24-40 (i.e. ... the GUI interface, documents... (collectively "objects") are visually represented on the workstation 116 display, such as with icons, tree structures and pull-down menus, and may be interacted with using known devices and methods such as

utilizing a mouse or track ball to control a visually represented pointing device which is then used to click, select, drag and drop the displayed representations... the GUI also permits creation and manipulation of relationships and associations among the various objects and visually displays such relationships and associations ...).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified '756 into '278 and '427 to provide a way, wherein a user interface was utilized for combining image by a drag and drop operation on the preview of printing. One of the ordinary skills in the art would have been motivated to perform such a modification to provide a print image forming device that capable of producing high quality document and the ability to manipulate the original document plus the instruction for producing the finishing product in either hard copy or electronic form, such as on floppy disk, compact disc or tape or can be transmitted to a printer over a network such as the Internet, as taught by '756 at col. 1, lines 15-45 (i.e.... capable of producing high quality...).

In regard to dependent claim 23, incorporate substantially similar subject matter as cited in claim 17 above, and is similarly rejected along the same rationale.

Response to Argument

4. Examiner has completed a through study of Applicant's Amendments of 12/09/2004; especially, Applicants' amendments to claims 24 and 18, which necessitated new ground of rejection to the intervening claims 15-17 and 21-23, however are moot in view of the new ground(s) of rejection.

5. Responses to Applicants requested in regard to IDS matter, Remarks page 6:
Form PTO-1449 had been acknowledged and considered by USPTO –Examiner - OIPE
dated 06/10/2004, if preferred a copy can be obtained at the PAIR system, URL
<http://pair-direct.uspto.gov>.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
the advisory action. In no event, however, will the statutory period for reply expire later
than SIX MONTHS from the mailing date of this final action

7. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Quoc A. Tran whose telephone number is (571) 272-
4103. The examiner can normally be reached on Monday through Friday from 8:30AM
to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SANJIV SHAH
PRIMARY EXAMINER

Quoc A. Tran
Patent Examiner
Technology Center 2176
February 18, 2005